



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/741,601	11/01/96	MICALI	S U/17957-0022
			EXAMINER

PATENT GROUP
FOLEY HOAG & ELIOT
ONE POST OFFICE SQUARE
BOSTON MA 02109

22M2/0627

SAVADIAN, H.	PAPER NUMBER
ART UNIT	

2202

DATE MAILED: 06/27/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on Application

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 2-82 ~~is/are~~ pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 2-82 ~~is/are~~ rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

GENERAL

1. Examiner also acknowledges receipt of the IDSs. At this time, there are some references in USPTO's custody that remain difficult to obtain, e.g., some of the provisional and related applications. When these applications are obtained, Examiner will initial and return the IDS forms.

OBJECTIONS/REJECTIONS NOT BASED ON PRIOR ART

DISCLOSURE: Claims

2. The ordering of the claims is objected to as containing intervening claims between claims and the claims that depend therefrom. This is not in accordance with 37 C.F.R. § 1.75 (g), which states: "(g) All dependent claims should be grouped together with the claim or claims to which they refer"

Before issue, claims of this patent application should be renumbered to conform with 37 C.F.R. § 1.75 (g).

REJECTIONS BASED ON PRIOR ART

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the bases for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled

the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The following is a quotation of 35 U.S.C. § 103 that forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 2-82 are rejected under 35 U.S.C. § 102(a) as being anticipated by Merkle.

6. Claims 2-82 are rejected under 35 U.S.C. § 102(b) as being anticipated by Merkle.

Merkle, either expressly or inherently, teaches all of the limitations of the claims.

7. Claims 2-82 are, moreover, rejected under 35 U.S.C. § 102(e) as being anticipated by Leighton.

Leghton, either expressly or inherently, teaches all of the limitations of the claims.

8. Claims 3-13, 15-24, 26-39, 41-55, 57-70, 72-76, 78-82 are, furthermore, rejected under 35 U.S.C. § 103 as being unpatentable over Chaum or Leighton, as applied to claims 2, 14, 25, 40, 56, 71, and 77, and further in view of what is well known in the art.

With respect to claim 6, for example, it is well known to have authentication centers provide third party verification. See, e.g., Bisbee teaching this feature. To provide for third party assumption of risk, therefore, it would have been obvious to incorporate an authority giving the root authentication in what Chaum teaches.

With respect to claim 41, for example, it is well known to provide certificate values to indicate which ones are revoked. See, e.g., Remark 13.31 on page 566, pp 576-577, and references discussed on pp 588 and 589 of Menezes. To avoid using unsafe keys, therefore, it would have been obvious to implement revocation certificates in what Chaum or Leighton teach.

REJECTIONS BASED ON DOUBLE PATENTING

9. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper extension of duration of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

10. Claims 2-82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-70 of copending application Serial No. 08/ 729,619. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 1-70 of copending application Serial No. 08/729,619 recite the limitations of the claims in the present application.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 2-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,432,852. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-12 inherently or expressly recite the limitations of claim

12. Claims 3-13, 15-24, 26-39, 41-55, 57-70, 72-76, 78-82 are, furthermore, rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,432,852 in view of what is well known.

With respect to claim 6, for example, it is well known to have authentication centers provide third party verification. See, e.g., Bisbee teaching this feature. To provide for third party assumption of risk, therefore, it would have been obvious to incorporate an authority giving the root authentication in what Chaum teaches.

With respect to claim 41, for example, it is well known to provide certificate values to indicate which ones are revoked. See, e.g., Remark 13.31 on page 566, pp 576-577, and references discussed on pp 588 and 589 of Menezes. To avoid using unsafe keys, therefore, it would have been obvious to implement revocation certificates in what Chaum or Leighton teach.

PRIOR ART RELEVANT TO EXAMINING THE APPLICATION

13. The following prior art, which is made of record, is considered pertinent to the application.

Micali ('804), Tysen, Chaum, Abadi, Matyas, Merkle ('264), and Micali ('982).

INFORMATION ON HOW TO CONTACT THE USPTO

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hrayr A. Sayadian whose telephone number is (703) 306-4169. The examiner can normally be reached on Monday through Friday, from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas Tarcza, can be reached on (703) 306-4171. The fax phone number for this Group is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-4177.

Hrayr A. Sayadian
6-21-1997



THOMAS H. TARCZA
SUPERVISORY PATENT EXAMINER
GROUP 2200